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Sadler, Breen, Morasch & Colby, ps
422 W. Riverside Ave, Suite 424
Spokane, WA 99201

EXAMINER
KIM, JUNG W

ART UNIT	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>24 November 2008</u>.

2a)☐ This action is **FINAL**.　　　2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-13 and 33-56</u> is/are pending in the application.

　　4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-13 and 33-56</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

　　Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

　　Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

　　a)☐ All b)☐ Some * c)☐ None of:

　　　1.☐ Certified copies of the priority documents have been received.

　　　2.☐ Certified copies of the priority documents have been received in Application No. _____.

　　　3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

　　* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>10/13/08</u>.

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

1.   This Office action is in response to the RCE filed on 11/24/08.

2.   Claims 1-13 and 33-56 are pending.

Continued Examination Under 37 CFR 1.114

3.   A request for continued examination under 37 CFR 1.114, including the fee set

forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this

application is eligible for continued examination under 37 CFR 1.114, and the fee set

forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action

has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on

11/24/08 has been entered.

Information Disclosure Statement

4.   The IDS submitted on 10/13/08 has been considered. An initialed copy is

enclosed.

Response to Arguments

5.   Applicant's arguments with respect to the prior art rejections based on Hu and

Heiner are persuasive. These rejections are withdrawn. However, upon further

consideration, a new ground(s) of rejection is made in view of Olkin.

6.   Applicant's arguments with respect to the prior art rejections based on Mathis in view of Hansmann have been considered, but they are not persuasive.

7.   On pg. 22, last paragraph of the Remarks, Applicant argues that Hansmann does not disclose the limitation "determining by said discovery machine whether said first user will accept a communication from said second user... wherein said direct link is not established if said first user does not accept said communication." However, contrary to Applicant's allegations, the Hansmann prior art suggests such a limitation. Hansmann discloses a network comprising mobile devices (the second client machine), a DRS (the discovery machine) and a number of backend systems (the first device) on a TCP/IP network, whereupon a mobile device connects to a backend system via the DRS. When a mobile device sends a request to the DRS to access a backend system, the DRS connects to the backend system defined by the selected application. Col. 5, line 42-col. 6, line 46; Fig. 2 and 3. Hansmann further discloses an embodiment where after the initial connection is made by the DRS, a direct link is then established between the client and the backend system. Col. 3, lines 24-38. One necessary feature of such a connecting process is a determination by the DRS that the backend system is willing to accept the connection by the DRS. Hence, Applicant's allegations that "the storage of data and tables in Hansmann is described as a kind of map for finding installed applications, [with] no teaching or suggestion beyond that" (Remarks, pg. 24) is not true, as Hansmann also discloses the DRS establishing a transmission with the backend system.

8.   For these reasons, claims 1-4, 6-8 and 13 remain rejected under the prior art of

record.

Specification

9.   The specification is objected to as failing to provide proper antecedent basis for

the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). New

claims 33-43 define "one or more computer readable tangible media"; however, the

specification does not provide an adequate support to define this new terminology.

Double Patenting

10.   The nonstatutory double patenting rejection is based on a judicially created
doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the
unjustified or improper timewise extension of the "right to exclude" granted by a patent
and to prevent possible harassment by multiple assignees.   A nonstatutory
obviousness-type double patenting rejection is appropriate where the conflicting claims
are not identical, but at least one examined application claim is not patentably distinct
from the reference claim(s) because the examined application claim is either anticipated
by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140
F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29
USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir.
1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422
F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163
USPQ 644 (CCPA 1969).
        A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d)
may be used to overcome an actual or provisional rejection based on a nonstatutory
double patenting ground provided the conflicting application or patent either is shown to
be commonly owned with this application, or claims an invention made as a result of
activities undertaken within the scope of a joint research agreement.
        Effective January 1, 1994, a registered attorney or agent of record may sign a
terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with
37 CFR 3.73(b).

11.   Claims 1, 2, 13, 33, 34, 44, 45 and 56 are rejected on the ground of nonstatutory

obviousness-type double patenting as being unpatentable over claims 1-8 of U.S.

Patent No. 7,124,435. Although the conflicting claims are not identical, they are not

patentably distinct from each other because the limitations of claims 1, 2, 13, 33, 34, 44,

45 and 56 are defined in claims 1-8 of patent 7,124,435.

Claim Rejections - 35 USC § 112

12.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly
> claiming the subject matter which the applicant regards as his invention.

13.   Claims 7 and 39 rejected under 35 U.S.C. 112, second paragraph, as being

indefinite for failing to particularly point out and distinctly claim the subject matter which

applicant regards as the invention.

14.   Claims 7 and 39 recite the limitation "said plurality of contact information." There

is insufficient antecedent basis for this limitation in the claims.

Claim Rejections - 35 USC § 101

15.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of
> matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the
> conditions and requirements of this title.

Claims 33-43 are rejected under 35 U.S.C. 101 because the claimed invention is

directed to non-statutory subject matter. Claims 33-43 are directed to a computer

readable medium. However, Applicant's specification does not limit the embodiments of

a computer readable medium having computer executable instructions stored thereon to

hardware. In fact, the specification provides no intrinsic evidence of the boundaries for

a computer readable medium. Hence, it would appear to be reasonable to interpret

media as fairly conveying signals and other forms of propagation or transmission media

to one of ordinary skill in the art.

Claim Rejections - 35 USC § 102

16.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by
> another filed in the United States before the invention by the applicant for patent or (2) a patent
> granted on an application for patent by another filed in the United States before the invention by the
> applicant for patent, except that an international application filed under the treaty defined in section
> 351(a) shall have the effects for purposes of this subsection of an application filed in the United States
> only if the international application designated the United States and was published under Article 21(2)
> of such treaty in the English language.

17.   Claims 1, 2, 4-13, 33, 34, 36-45 and 47-56 are rejected under 35 U.S.C. 102(e)

as anticipated by Olkin et al. US 6,584,564 (hereinafter Olkin).

18.   As per claims 1, 2 and 4-13, Olkin discloses a method comprising:

   a.   registering a first user associated with a first client machine and a second

   user associated with a second client machine with a discovery machine (6:33-61;

   10:31-35, database of clients);

   b.   determining by said discovery machine whether said first user will accept

   a communication from said second user (11:10-12);

c.   if said first user will accept said communication, establishing a direct link between said first client machine and said second client machine to deliver said communication in which said direct link: if established is configured such that said communication is not delivered through said discovery machine; and is not established if said first user will not accept said communication (fig. 1, reference no. 38 and 40);

d.   wherein said direct link is caused to be closed after said communication is delivered (by virtue of terminating a communication);

e.   Wherein a new direct link is established between said second client machine and said first client machine to communicate a new communication (each successive communication requires a new link);

f.   Wherein a thread of related previous communications is prefixed to said new communications (e-mail messages include prior communications)

g.   Wherein at least one of said first user and second user maintains a plurality of contact information; wherein an individual entry in said plurality of contact information is automatically updated when an associated user of said individual entry locally at a client machine of said associated user (5:62-6:1- conventional e-mail applications provide updateable address books; 11:18-29);

h.   Wherein a third user can initiate a new communication to at least one of said first and said second user via a web page interface coupled to said discovery machine (col. 5:62-6:11; 7:63-8:27);

i.   Wherein a third user can initiate a new communication to at least one of said first and second user through a simple mail transfer protocol via said discovery machine (7:63-8:1; 10:4-10, a message can be sent either securely [i.e. via the security server] or by conventional means);

j.   Wherein at least one of said first user and second user can selectively block said new communication (11:10-12);

k.   Wherein a one-directional communication link is sent to said third user when at least one of said first user replies to said new communications and wherein said one-directional communication allows said third user to send a future communication directly to said first or second user (fig. 1, sender and receiver; 10:4-10, a message can be sent either securely [i.e. via the security server] or by conventional means);

l.   Wherein determining that said first user will accept said communication includes storing notification of said communication if said first user is unavailable (6:50-55; e-message notifications are stored by conventional e-mail applications; 15:1-4)

m.   Wherein said discovery machine is a central server (fig. 1, reference no. 24).

19.   As per claims 33, 34 and 36-43, they are claims corresponding to claims 1, 2 and 4-13, and they do not teach or define above the information claimed in claims 1, 2 and

4-13. Therefore, claims 33, 34 and 36-43 are rejected as being anticipated by Olkin for the same reasons set forth in the rejections of claims 1, 2 and 4-13.

20.　　　As per claims 44, 45 and 47-56, they are claims corresponding to claims 1, 2 and 4-13, and they do not teach or define above the information claimed in claims 1, 2 and 4-13. Therefore, claims 44, 45 and 47-56 are rejected as being anticipated by Olkin for the same reasons set forth in the rejections of claims 1, 2 and 4-13.

Claim Rejections - 35 USC § 103

21.　　　Claims 3, 35 and 46 are rejected under 35 U.S.C. 103(a) as being obvious over Olkin.

22.　　　As per claim 3, the rejection of claim 1 under 35 USC 102(e) as being anticipated by Olkin is incorporated herein. In addition, Olkin discloses sending an e-mail from a security server to a receiver to inform the receiver that an encrypted message will be arriving soon and that the receiver will need to register in order to receive it. Col. 6:44-55. Although Olkin does not expressly disclose wherein if said first user is not available to receive said communication, said communication is stored by said discovery machine until said first user becomes available, it is notoriously well known in the networking art to temporarily store a communication until a receiving end becomes available. For example, connection oriented communications require that a receiver respond to a connection request before any communication is transmitted; typically, communications

are temporarily stored until a response is received or the request times out. Official

notice of this teaching is taken. Therefore, it would be obvious to one of ordinary skill in

the art at the time the invention was made to store the communication by said discovery

machine until said first user becomes available if said first user is not available to

receive said communication. One would be motivated to do so to ensure that the first

user actually receives the communication. The aforementioned cover the limitations of

claim 3.

23.   As per claim 35, it is a claim corresponding to claim 3, and it does not teach or

define above the information claimed in claim 3. Therefore, claim 35 is rejected as

being unpatentable over Olkin for the same reasons set forth in the rejections of claim 3.

24.   As per claim 46, it is a claim corresponding to claim 3, and it does not teach or

define above the information claimed in claim 3. Therefore, claim 46 is rejected as

being unpatentable over Olkin for the same reasons set forth in the rejections of claim 3.

25.   Claims 1-4, 6-8, 13 33-36, 38-40, 44-47, 49-51 and 56 are rejected under 35

U.S.C. 103(a) as being unpatentable over Mathis in view of Hansmann et al. USPN

6,941,148 (hereinafter Hansmann)

26.   As per claims 1, 2, 4, 6-8 and 13, Mathis discloses a method comprising:

n.   initiating a communication from a second user via a second client machine

to a first user via a first client machine; (fig. 1 and 3)

o.   determining that the first user will accept the communication; (col. 3:39-40

and lines 54-55)

p.   establishing a direct link between the first client machine and the second

client machine; and delivering the communication; (col. 3:63-4:12)

q.   wherein the direct link is not established if the first user does not accept

the communication; (3:40-41)

r.   wherein the direct link closes after the communication is delivered; (4:10-

12)

s.   further comprising the step of the second user initiating a new

communication to the first user by establishing a new direct link between the

second user machine and the first user machine. (3:63-4:12)

27.   Mathis does not disclose the first user and the second user registering with a

discovery machine, wherein the discovery machine is coupled to the network; wherein

the discovery machine is coupled to the network; wherein the communication is initiated

via the discovery machine; the discovery machine determining whether the first user will

accept the communication from said second user; the discovery machine establishing a

direct link between the first client machine and the second client machine if it is

determined the first user will accept the communication, otherwise, a direct link is not

established; wherein at least one of the first user and the second user maintains a

plurality of contact information; wherein an individual entry in the plurality of contact

information is automatically updated when an associated user of the individual entry updates a corresponding entry locally at a client machine of the associated user; wherein a third user can initiate a new communication to at least one of the first and the second user via a web page interface coupled to the discovery machine; wherein the discovery machine is a central server. Hansmann discloses a network comprising mobile devices (the second client machine), a DRS (the discovery machine) and a number of backend systems (the first device) on a TCP/IP network; the DRS incorporates a list of backend systems by which a registered user device can connect to a backend system. Col. 2:40-55 and lines 65-67; fig. 3. When a mobile device sends a request to the DRS to access a backend system, the DRS connects to the backend system defined by the selected application. Col. 5, line 42-col. 6, line 46; Fig. 2 and 3. Hansmann further discloses an embodiment where after the initial connection is made by the DRS, a direct link is then established between the client and the backend system. Col. 3, lines 24-38. Hansmann discloses that such a feature scales well: it enables a user device to connect with ever increasing services in a flexible manner without knowing in advance which backend system provides the required service. (2:1-6) Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made for the first user and the second user to register with a discovery machine, wherein the discovery machine is coupled to the network; wherein the communication is initiated via the discovery machine; the discovery machine determining whether the first user will accept the communication from said second user; the discovery machine establishing a direct link between the first client machine and the

second client machine if it is determined the first user will accept the communication,
otherwise, a direct link is not established; wherein at least one of the first user and the
second user maintains a plurality of contact information; wherein an individual entry in
the plurality of contact information is automatically updated when an associated user of
the individual entry updates a corresponding entry locally at a client machine of the
associated user; wherein a third user can initiate a new communication to at least one
of the first and the second user via a web page interface coupled to the discovery
machine; wherein the discovery machine is a central server. One would be motivated to
do so for a more flexibility means of connecting a client to a plurality of other nodes as
taught by Hansmann, ibid. The aforementioned cover the limitations of claims 1, 2, 4, 6-
8 and 13.

28.   As per claim 3, the rejection of claim 1 under 35 USC 103(a) as being
unpatentable over Mathis in view of Hansmann is incorporated herein. In addition,
Hansmann discloses that the registry server establishes a connection to the backend
system via its backend router, wherein the router holds tables that define on which
backend system the required application is installed. It is further notoriously well known
in the art for routers to implement queuing disciplines; for example, in the event that a
destination is not available, a router implementing a fair queuing technique will queue
the flow directed to a nonresponsive destination. Official notice of this teaching is taken.
Therefore, it would be obvious to one of ordinary skill in the art at the time the invention
was made such that if the first user is not available to receive the communication, the

communication is stored by the discovery machine until the first user becomes available. One would be motivated to do so to handle latency experienced by the communication. The aforementioned cover the limitations of claim 3.

29.   As per claims 33-36 and 38-40, they are claims corresponding to claims 1-4, 6-8 and 13, and they do not teach or define above the information claimed in claims 1-4, 6-8 and 13. Therefore, claims 33-36 and 38-40 are rejected as being unpatentable over Mathis in view of Hansmann for the same reasons set forth in the rejections of claims 1-4, 6-8 and13.

30.   As per claims 44-47, 49-51 and 56, they are claims corresponding to claims 1-4, 6-8 and 13, and they do not teach or define above the information claimed in claims 1-4, 6-8 and 13. Therefore, claims 44-47, 49-51 and 56 are rejected as being unpatentable over Mathis in view of Hansmann for the same reasons set forth in the rejections of claims 1-4, 6-8 and13.

Communications Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jung W. Kim whose telephone number is 571-272-3804. The examiner can normally be reached on M-F 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on 571-272-3799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Business Center (EBC) at 866-217-9197 (toll-free).

/Jung Kim/
Primary Examiner, AU 2432